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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,335	01/19/2001	Mark A. Stevens	2000.034/1109.007	7723
30636	7590	05/01/2007	EXAMINER	
FAY KAPLUN & MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038			HUYNH, CONG LACT	
		ART UNIT		PAPER NUMBER
		2178		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/766,335	STEVENS, MARK A.
	<b>Examiner</b>	<b>Art Unit</b>
	Cong-Lac Huynh	2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 05 June 2006.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-38 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-38 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 9/3/04.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. In view of the appeal brief filed on 6/5/06, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



STEPHEN HONG  
SUPERVISORY PATENT EXAMINER

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 35 and 38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding the system claim 35, it appears that the claim is merely a software *per se* without any piece of hardware of a system for the software to be executed thereon.

Therefore, the system as claimed is non-statutory.

Regarding independent claims 1 and 38, the claims are directed to a translator for translating a source file to a target file. The translator, which is merely a functional descriptive material, without being embodied in a computer readable medium is not statutory since the function of the descriptive material is not realized. See MPEP 2106  
(..*When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.*..)

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-20, 22-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grobler et al. (US Pat App Pub No 2002/0052893 A1, 5/2/02, filed 12/13/00) in view of Gemma (US 4,910,704, 3/20/90).

Regarding independent claim 20, Grobber discloses:

- identifying a feature set of a source file ([0062]-[0067], [0018]-[0021]: identify the tags of a table in the source file where said tags, which is a set of tags, represent the table feature)
- storing and analyzing the feature set in a buffer (figures 8-9, #820-855: the fact that the source data is temporarily stored and analyzed and a target table is created for filling the target format implies that there is a buffer for performing storing and creating)
- writing the feature set into a target file in the target format (figure 7, [0068]-[0073], [0021]: writing the source table into the target table in the target file by converting the source table tags into the target table tags)

Grobber does not disclose assembling the feature set in a buffer.

Gemma discloses editing data stored in a buffer (col 1, lines 58-67, col 2, lines 34-39).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Gemma into Grobber for the following reason. The ability of editing data stored in a buffer in Gemma provides the advantage to incorporate into the data stored in a buffer in Grobber for assembling the feature set in a buffer since

editing data is one way of assembling feature data in the buffer where data is reorganized and rearranged.

Regarding claim 22, which is dependent on claim 20, Grobber discloses that features of the feature set are selected from the group consisting of paragraph style, straddled cells in a table, cross-referencing, pen styles in a drawing, other document formatting, document header specification, document footer specifications, discontinuity indicator, order indicators, location indicators, beginning indicators, ending indicators, data types, data translation pairs, document macros, implied features, implied feature endings, and combination thereof ([0061]: the beginning indicators and the ending indicators of the table tags are selected).

Regarding claim 23, which is dependent on claim 20, Grobber discloses mapping code fragments of the source file to a feature list ([0045], [0048]).

Regarding claim 24, which is dependent on claim 23, Grobber discloses looking up the code fragments in a front-end lookup table ([0048]-[0052]).

Regarding claim 25, which is dependent on claim 24, Grobber discloses permitting the front-end lookup table to be user modifiable ([0053], [0069]).

Regarding claim 26, which is dependent on claim 20, Grobber discloses mapping the feature set to code fragments of the target file ([0049]-[0050], [0057]-[0058]).

Regarding claim 27, which is dependent on claim 26, Grobber discloses looking up the feature set in a back-end lookup table (figures 4-5, [0050]-[0051]: making selections regarding the format of the individual columns selected for the target table implies a provided list or table for looking up the table tags before selecting).

Regarding claims 28 and 29, which are dependent on claim 20, Grobber discloses identifying a feature set of a plurality of source files having a plurality of source formats writing the feature set into a plurality of target files having a plurality of target formats ([0023]: the fact that the data transformation from a source file to a target file can be applied to a *plurality of documents at the same time* implies that said data can be identified in a plurality of source files having different formats and written to a plurality of target files having of course a plurality of target formats).

Regarding claim 30, which is dependent on claim 20, Grobber discloses identifying tokens disposed within the source file, and associating the tokens with the feature list ([0065]: the token “Boston” disposed in the source file is identified and associated with the tags <TH> and </TH> among the other table tags).

Regarding claim 31, which is dependent on claim 20, Grobber discloses using a source file generator to initiate translation by the translator ([0080])

Regarding claim 32, which is dependent on claim 20, Grobber discloses using a target file adapter module to perform secondary translation ([0080],[0085]).

Regarding claim 33, which is dependent on claim 32, Grobber discloses the target file adapter module translates the target file into another target format ([0080]-[0086]).

Regarding independent claim 34, Grobber discloses:

- providing a feature identifier to determine a feature set of the source file ([0062]-[0067], [0018]-[0021]: determine the tags of a table in the source file where said tags, which is a set of tags, represent the table feature)
- providing a buffer to store and analyze the feature set (figures 8-9, #820-855: the fact that the source data is temporarily stored and analyzed and a target table is created for filling the target format implies that there is a buffer for performing storing and creating)
- providing a feature writer to write the feature set into the target file in the target format (figure 7, [0068]-[0073], [0021]: writing the source table into the target table in the target file by converting the source table tags into the target table tags)

Grobber does not disclose providing a buffer to assemble the feature set .

Gemma discloses editing data stored in a buffer (col 1, lines 58-67, col 2, lines 34-39). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Gemma into Grobber for the following reason. The ability of editing data stored in a buffer in Gemma provides the advantage to incorporate into the data stored in a buffer in Grobber for assembling the feature set in a buffer since editing data in a buffer is one way of assembling feature data in the buffer where data is reorganized and rearranged.

Independent claim 35 is a system for method claim 34, and is rejected under the same rationale.

Independent claims 36 and 37 are an article of manufacture and a computer readable program code for method claim 34, and are rejected under the same rationale.

Claims 1-12, 15-18 are for a translator of method claims 20-33, and are rejected under the same rationale.

Regarding claims 13-14, Grobber discloses the translator comprises a user interface where the user interface comprises a GUI (figures 4-5).

Regarding claim 19, which is dependent on claim 1, Grobber discloses that the source and the target formats are selected from the group consisting of MIF, RTF,

WordPerfect, VENTURA, Microsoft Word, Interleaf, HTML, SGML, XML, C, C++, Visual Basic, Pascal, Java, MFC, PowerPlant, Swing, SVG, HPJ, Flash, WMF, VRML, RenderMan, 3DMF, and combination thereof ([0080]).

Regarding independent claim 38, Grobber discloses a translator comprising:

- a feature identifier having a front-end lookup table to map code fragments of the source file to a list of features to determine a feature set of the source file ([0048]-[0052], [0062]-[0067], [0018]-[0021])
- a buffer to store and analyze the feature set (figures 8-9, #820-855: the fact that the source data is temporarily stored and analyzed and a target table is created for filling the target format implies that there is a buffer for performing storing and creating)
- a feature writer having a back-end lookup table to map the feature set to HTML code fragments, to write the feature set into the target file in the HTML format (figure 7, [0068]-[0073], [0021], figures 4-5, [0050]-[0051])

Grobber does not disclose:

- a buffer to assemble the feature set
- the code fragments of the source file is the MIF code

Gemma discloses editing data stored in a buffer (col 1, lines 58-67, col 2, lines 34-39).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Gemma into Grobber for the following reason. The ability of editing data stored in a buffer in Gemma provides the advantage to incorporate into

the data stored in a buffer in Grobber for assembling the feature set in a buffer since editing data in a buffer is one way of assembling feature data in the buffer where data is reorganized and rearranged.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Grobber to include MIF into Grobber since Grobber discloses the format of the source file can be *any format* used by a database application, and the format of the target file can be in any tag language such as HTML or XML [0080]. This motivates to use MIF code as a format of the source file in exchanging the formats between the source documents and the target documents.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Maule et al. (US 5,915,126).

Ledgard et al. (US 6,023,556).

Nakata (US 7,092,115).

Yamamoto (US 2002/0029306).

Shu et al., Convert: A High Level Translation Definition Language for Data Conversion, ACM 1975, pages 557-567.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Thurs (9:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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04/27/07